

REMARKS/ARGUMENTS

Reconsideration of the objections and rejections set forth in the Final Office Action in view of the following remarks is respectfully requested. Applicants believe that the present case is now in condition for Allowance or in better form for Appeal.

The following remarks are in response to the Final Office Action mailed October 29, 2003. In the Office Action, the Examiner objected to claims 23 and 39 and rejected claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, 54-57, under 35 U.S.C. §103. Reconsideration in light of the following remarks made herein is respectfully requested.

As will be discussed, Applicants respectfully traverse the Office Action's contentions that a prima facie case of obviousness has been established and respectfully traverses the rejection in its entirety.

It should be noted that Applicants have amended independent claims 3 and 17 in order to remedy a typographical error.

Further, Applicants have amended claims 23 and 32, such that they are both dependent from independent claims 17, in order to overcome the Examiner's objections. Applicants respectfully request that these objections be removed.

Again, Applicants respectfully submit that the claims are now either in condition for Allowance or in better form for Appeal. If the Examiner believes a teleconference would be useful in the prosecution of this case, the Examiner is invited to contact the Applicants' attorney.

Rejections Under 35 U.S.C §103

Claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 stand rejected under 35 U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 6,279,112 B1 issued to O'Toole Jr. et (hereinafter O'Toole) in view of U.S. Patent No. 5,796,952 issued to Davis et al. (hereinafter Davis).

Applicants respectfully traverse the Office Actions §103 obviousness rejections in their entirety, in light of the following remarks. As stated in MPEP §2141.03:

A prima facie obviousness rejection requires the three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references of themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP §2142. (Emphasis added).

MPEP §2141.03 further warns that *impermissible hindsight must be avoided*.

Furthermore, with regards to obviousness, as aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.

Applicants respectfully submit that the limitations of independent claims 3 and 17 are not taught, suggested or rendered obviousness by O'Toole in combination with Davis in combination with what the Office Action alleges would have been obvious to one of ordinary skill in the art. Moreover, as will be discussed, Applicants respectfully submit that the Office Action is utilizing *impermissible hindsight* to piece together the disparate references of O'Toole and Davis along with what would have been allegedly obvious to one of ordinary skill in the art to, *in hindsight*, approximate Applicant's claimed invention.

Both of Applicants' independent claims 3 and 17 generally relate to a system comprising a target computer to receive a content including an advertisement...in which the content provider comprises a user rule page containing information *automatically obtained from the target computer by a first agent*, the first agent having a triggering program to filter information and

determine whether the information is relevant to the user rule page...a rulebook to provide a rule based on the user rule page, the rule controlling the content to be transmitted from a database to the target computer...the user rule page including at least one of *a hardware profile* indicating hardware capabilities of the target computer, *a software profile* indicating software used by the target computer, and a user profile including *dynamic information* related to a user using the target computer, *the dynamic information including information on web sites visited and time spent by the user on the web sites...wherein a second agent updates information in the user rule page based upon information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.*

On page 5 of the Office Action, the Office Action alleges that O'Toole teaches a second agent that updates information in the user rule page based upon information received from the target computer and based upon an updated user rule page finds new appropriate content including a second advertisement that is transmitted to the target computer.

In support of this, the Office Action cites column 7, lines 24-43 of O'Toole, which discloses the following:

The client computer fetches a document of web-based information from the offer-providing server that contains a smart digital offer object (step 118). The smart digital offer object may be an executable program or program fragment expressed in machine-executable form, such as an ActiveX applet, and protected against unauthorized tampering by means of an authenticator such as a digital signature or MAC code, or the smart digital offer object may be a digitally signed set of inputs to a program already residing at the client computer. The smart digital offer object received by the client computer may be protected against unauthorized tampering by means of a digital signature or MAC code. In an alternative embodiment the smart digital offer object remains at the offer providing server and need not be protected against tampering. The client computer activates the smart digital offer object (step 120), and the smart digital offer object attempts to observe the parameters of the execution environment at the client machine, including the presence of coupons, and possibly other information such as a purchasing history recorded on the client computer.

The Office Action further alleges that column 10, lines 18-21 of O'Toole which states that: "the server computer may use the subset of the client personal profile to customize other web-based services offered to the user, including digital coupons, search services, and advertisements" teaches the same.

However, these citations by the Office Action, nowhere teach, suggest or render obvious a second agent that updates information (after a first agent) in a user rule page based upon information received from the target computer and based upon the updated user rule page finds new appropriate content including a second advertisement that is transmitted to the computer.

Because O'Toole does not teach or suggest a *second agent that updates user information in a user rule page and based upon the updated user rule page finds a new appropriate second advertisement*, this limitation is totally missing, and therefore O'Toole cannot render obviousness Applicant's claimed invention of independent claims 3 and 17.

Further, there is no mention in O'Toole of a *second agent operating after a first agent to find a new appropriate second advertisement based upon an updated user rule page* wherein the *user rule page* includes at least one of a *hardware profile* indicating hardware capabilities of the target computer, *software profile* indicating software used by the computer, and a *user profile including dynamic information* related to the user using the target computer *including information on websites visited and time spent by the user on the website*.

However, the Office Action nonetheless tries to piece together disparate elements from Davis in order to further approximate the limitations of independent claims 3 and 17.

Davis is cited merely to teach the ability of an agent that can be used to obtain data regarding the hardware characteristics of a target computer. As the Office Action recognizes on page 7, O'Toole does not explicitly disclose how the confirmation of compatibility between the client and the server's communication hardware and software is established. However, as the Office Action recognizes, Davis, like O'Toole, also does not teach the use of a software profile. Instead, the Office Action takes official notice that it is old and well known in the art of computers to access a software profile.

Davis is further cited to show that it has been known to track dynamic information including information on websites visited and time spent by the user on the websites; in order to further try to approximate Applicant's independent claims 3 and 17.

As pointed out by the Federal Circuit, reliance solely on "skill in the art," is generally insufficient to modify a reference to reach an obviousness judgment. In *Al-Site*, the Federal Circuit stated: "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171, (Fed. Cir. 1999) (emphasis added). Applicants respectfully submit that there is no teaching or suggestion in the two references, along with the skill in the art component, cited by the Office Action, in order to render obvious Applicants' amended independent claims 3 and 17.

This is because neither of the references, alone or in combination, teach or suggest *a second agent (operating after a first agent)* that updates information in a user rule page based upon information received from a target computer and based upon the updated user rule page finds new appropriate content *including a second advertisement* that is transmitted to the target computer wherein the user rule page includes at least one of a *hardware profile* indicating hardware capabilities of the target computer, a *software profile* indicating software used by the target computer, *and a user profile including dynamic information* including information on websites visited and time spent by the user on the websites. In fact, the only suggestion of a software profile is that the Office Action states it would have been known in the art.

Based on the foregoing, Applicants respectfully submit that there is no teaching or suggestion in the two references, along with ordinary skill in the art, to render obvious the elements and the interaction of elements of Applicants' claimed invention as set forth in Applicants' independent claims 3 and 17. Quite simply, there is no teaching or suggestion in either of the references, alone or in combination, with or without what would have been allegedly apparent to one skilled in the art, to teach, suggest, or render obvious the elements and interaction of elements of Applicants' independent claims 3 and 17, *except for impermissible hindsight*. Accordingly, Applicants respectfully request that the rejection of independent claims

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Reply to Office action of 10/29/2003

3 and 17 be withdrawn. Further, the dependent claims are allowable for being dependent upon allowable base claims.

Conclusion


In view of the remarks made above, it is respectfully submitted that pending claims 3-5, 17, 18, 22-25, 27-29, 32, 36, 40, 41, 45-49, and 54-57 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 12/02/2003

By


Eric T King
Reg. No. 44,188
Tel.: (714) 557-3800 (Pacific Coast)

Attachments

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

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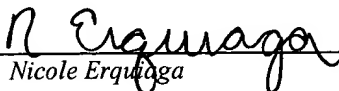
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